

25



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,416	05/18/2001	John William Lumley	1509-176	4833

7590 12/01/2004

IP Administration  
C/o Hewlett-Packard Company  
Mail Stop 35  
3404 East Harmony Road  
Ft. Collins, CO 80528-9599

EXAMINER

QIN, YIXING

ART UNIT PAPER NUMBER

2622

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/859,416

Applicant(s)

LUMLEY, JOHN WILLIAM

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 5/18/2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The following claims are missing from the amended version of the claim, but appear later in the marked-up version showing changes :

- Claim 2
- Claim 7
- Claim 16

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

I. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Manico et al (U.S. Patent No. 6,322,260).

The Manico et al reference discloses a method and an apparatus for developing film from a photosensitive media. The reference discloses methods and apparatus for the printing of order sheets and the use of these sheets for the ordering of images to be 3printed.

**1. Claim 1**

**A method for selecting prints of photographs from a digital film medium, the method comprising:**

- **(i) printing a selection sheet of thumbnail representations of photographs available on the medium to be printed, the selection sheet further comprising a plurality of selection fields, each thumbnail representation being associated with at least one selection field',**

- (ii) marking one or more of said selection fields according to a user choice of photographs to be printed;
- (iii) inspecting the selection sheet to determine which of said selection fields has been marked in step (ii);
- (iv) performing one or more actions relating to the photographs stored on said digital medium, in accordance with said marked selection fields.

Regarding claim 1, The Manico reference discloses :

- in Fig. 12 an example of an “order form” with thumbnail images.
- in column 10, lines 22-28 that :
  - “[t]he printer 80 may also provide an order form 106 (**“selection sheet of thumbnail representations of photographs available on the medium to be printed”**), such as illustrated in Fig. 12.
  - The order form 106, is similar to receipt 81 but also includes order selection boxes 119 (**“a plurality of selection fields”**) that can be filled out by the customer. (**“marking one or more of said selection fields according to a user choice of photographs to be printed”**).
  - The form 16 [should be 106] can then be fed into the apparatus through a receipt order slot 110 for reading and placement of the order. (**“inspecting the selection sheet to determine which of said selection fields has been marked in step (ii)”**)

- The order is then submitted to the appropriate location for completion.  
**(“performing one or more actions relating to the photographs stored on said digital medium, in accordance with said marked selection fields.”)**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claim 2-10, 12,13, 16-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al (U.S. Patent No. 6,322,260)

#### **2. Claim 2.**

- **for each thumbnail representation a corresponding plurality of selection fields are provided.**

Regarding claim 2, from the claim 1 rejection above, Manico et al discloses :

- in Fig. 12, that each image had 1 selection box associated with it. However, it would be obvious to one of ordinary skill in the art at the time of the invention to simply add more boxes depending on the number of options that is to be

provided to a user marking the boxes. The motivation would be to allow more flexibility in allowing customers to further customize the images to be printed.

**3. Claim 3**

- **step (iv) is a printing step and one type of said corresponding plurality of selection fields designates a print format in which the photograph represented by said thumbnail representation is to be printed in step (iv).**

Regarding claim 3, Manico et al discloses :

- in column 10, lines 38-44 that “[t]here are a variety of image products that may be ordered...[such as] hardcopy prints on photographic paper or other media...”  
Although Manico does not disclose a selection field to select the different types of prints, it would have been clear that a field for print format was needed in order to tell the machine which format the images were supposed to be printed in.

**4. Claim 4.**

- **step (iv) is a printing step and one type of said corresponding plurality of selection fields designates a number of prints of photographs corresponding to a particular thumbnail representation to be printed in step (iv) .**

Regarding claim 4, Manico et al discloses :

Art Unit: 2622

- in column 10, lines 29-31 that “[t]he system allows the user to take the images home and decide on the order as to whether or not additional copies or modifications are to be made.” Again, although Manico does not disclose a selection field to select the number of copies, it would have been clear that there had to have been a selection for the number of copies in order to tell the machine how many images to print.

**5. Claim 5**

- **one type of said corresponding plurality of selection fields is a "deletion" field which, when marked, designates that a particular photograph corresponding to the marked deletion field is to be deleted from the film medium in step (iv).**

Regarding claim 5, the deletion of images from memory is a well-known process for saving storage in various storage mediums (such as RAMs, hard disks, removable storage, etc.) Although the Manico et al reference does not disclose any fields for the deletion of images, it would be a clear advantage to having such a field in order for the customer to easily delete unwanted images from the image storage medium.

**6. Claim 6**



Art Unit: 2622

- **selection sheet is also provided with an identifier which is unique to the digital film medium and, wherein, in step (iii) said unique identifier is inspected in a preliminary step and,**
- **if the unique identifier does not correspond to a unique identifier allocated to the digital film medium, then the method terminates.\*\*\***

Regarding claim 6, Manico et al discloses :

- in Fig. 11 and column 9, lines 64-67, that “[t]he receipt 81 can include a variety of information, for example a unique order number 108...”

## **7. Claim 7**

- said unique identifier comprises a bar code.

Regarding claim 7, Manico et al discloses :

- in Fig. 11 (item 108 ) and column 9 line 67 and column 10, lines 1-4, that “...the image ID 109 is a bar code which is unique for each image. The order number 108 and image ID 109 may be provided in any desired format, preferably a machine readable format.” From Fig. 11, the unique order number 108 seems to be a bar code as well, even though Manico et al does not explicitly state so.

Art Unit: 2622

**8. Claim 8**

- **step (iv) is a printing step and in step (ii) a user fills in one or more of the selection fields according to user choice of photograph to be printed, user choice of number of prints of said photographs to be printed and user choice of format of said photograph to be printed.**

Claim 8 is a combination of the second limitation of claim 1, claim 3, and claim 4.

Please refer to the rejections of the limitations in the mentioned claims for the rejection to claim 8.

**9. Claim 9**

- **marking of said selection fields in step (ii) comprises filling in said selection field so as to change said selection field from a light, unselected, condition to a dark, selected, condition.**

Regarding claim 9, Manico et al discloses :

- The order form 106, is similar to receipt 81 but also includes order selection boxes 119 (“**a plurality of selection fields**”) that can be filled out by the customer. From Fig. 12 of Manico et al, it appears that the selection field (item 119) is in a “**light, unselected condition.**” Although Manico et al does not explicitly disclose that the marking/filling of the field(s) in a form turns it into a

dark, selected, condition, it would have been obvious that filling of a field involved darkening the field that represented the field. The motivation would be so that a person or a machine reading the order form can identify which pictures are to be ordered.

**10. Claim 10.**

- **in said step (iii) the marked selection sheet is scanned.**

Regarding claim 10, Manico et al discloses :

- The form 16 [should be 106] can then be fed into the apparatus through a receipt order slot 110 for reading and placement of the order. As mentioned before, the order form (Fig. 12, item 106) has barcodes for each thumbnail picture (Fig. 12 item 109) as well as a barcode to identify the order form (Fig. 12 item 108). Although Manico et al does not explicitly disclose the scanning of the order, it is well known that readers (such as barcode readers) scan barcodes (such as the ones on the form) to obtain information. This enables the process of ordering to be automated through the use of a machine, which effectively increases the rate of orders that can be filled.

**11. Claim 12.**

- **a printer including a scanning mechanism in a feed path of the printer, wherein**
- **in step (i) the selection sheet is printed on the basis of data input directly to the printer by means of a digital film media interface,**
- **the printer being arranged to print out said selection sheet which is thereafter,**
- **in step (ii), manually marked by a user according to the user choice, the mark selection sheet then being input to the printer feed path and scanned by the scanning mechanism so as to perform**
- **the inspecting step (iii), data obtained during the inspecting step then being used so as to enable the printing**
- **in step (iv) of said one or more photographs.**

Regarding claim 12, Manico et al discloses :

- in Figs. 1-5 a photofinishing apparatus (item 10)
- in column 4, lines 61-63, that “[a] digital scanner 40...is provided for scanning images developed on film 13.”
- in column 1, lines 17-18, that “[a] transport mechanism is provided for moving file 13 along a film processing path 34.” From the figures, one can see that the scanner located next to the processing path.
- in column 4, lines 63-66, that “[t]he scanner 40...can scan the images [from the film] and produce a digital record of the images scanned.”

Art Unit: 2622

- in column 10, lines 22-26 that “[t]he printer 80 may also provide an order form 106 that can be filled out by the customer.” (“**selection sheet...manually marked by a user**”)
- in column 10, lines 26-28, that “[t]he form 16 [should be 106] can then be fed into the apparatus through a receipt order slot 110 for reading and placement of the order.”
- in column 10, lines 45-47, “...images are forwarded to a central printing station where the order is completed and then forwarded to the customer.”

12. 13. A digital film enabled printer,

- said printer including a print head,
- a first interface for reading data from a digital film medium,
- a user interface for receiving commands from a user,
- a detector located in a paper feed path of the printer,
- a processor for processing data from said digital film medium and user commands from said user interface,
- the processor being arranged to create and to print out, using the print head, a selection sheet of thumbnail representations for photographs available on the medium to be printed,

- wherein said selection sheet further comprises a plurality of selection fields, each of said thumbnail representation being associated with at least one of said selection fields,
- the processor being further arranged for processing data from said detector so as to enable a user marked selection sheet input to the printer via the printer feed path to be inspected and a determination to be made as to which, if any, selection fields have been marked by the user and
- to enable the performance of one or more actions relating to the photographs stored on the digital film medium in accordance with the marked selection fields.

Regarding claim 13, Manico et al discloses :

- in Figs. 1-5 a photofinishing apparatus (item 10)
- in column 10, lines 57-60, that another embodiment of his invention "...includes an inkjet printhead 220..." Although this is not the same embodiment as the invention shown in Figs. 1-5, the printer (item 80 of Figs. 1-5) can very well be an inkjet printer, because inkjet printers are old and well known.
- in column 4, lines 61-63, that "[a] digital scanner 40...is provided for scanning images developed on film 13." Also, in column 1, lines 17-18, "[a] transport mechanism is provided for moving file 13 along a film processing path 34." One can see from Figs. 1 that the scanner ("**detector**") is located in the film processing path.

Art Unit: 2622

- in column 6, lines 20-22, that the “[a]pparatus 10 further includes a keypad 82 for allowing entry of information by the user...”
- in column 6, lines 28-35, that “[t]he computer 84 obtains information from the various components and sensors...[and] is appropriately connected with the magnetic read/write head 38, the scanner 40, printer 80, keypad 82 and CRT 42. The computer is also used to control the general operation of apparatus 10 and all the other components, sensor, motors and controls in apparatus 10.” It is inherent that the computer would have a processor. The limitations of processing data and to enable printing using the processor falls within the capabilities of the disclosed computer (i.e. used to control the general operations of the apparatus and all other components)
- in Fig. 12 and in column 10, lines 22-28 that “[t]he printer 80 may also provide an order form 106, such as illustrated in Fig. 12. The order form 106, is similar to receipt 81 but also includes order selection boxes 119 that can be filled out by the customer.”
- in column 10, lines 27-28, that one of the actions to perform is to “[submit the order form] to an appropriate location for completion.”

### 13. Claim 16

- **for each thumbnail representation printed a plurality of selection fields are printed.**

Regarding claim 16, from the claim 1 rejection above, Manico et al discloses :

- in Fig. 12, that each image had 1 selection box associated with it. However, it would be obvious to one of ordinary skill in the art at the time of the invention to simply add more boxes depending on the number of options that is to be provided to a user marking the boxes. The motivation would be to allow more flexibility in allowing customers to further customize the images to be printed.

**14. Claim 17.**

- **one type of said plurality of selection fields designates, when marked, the print format in which the photograph represented by said thumbnail representation is to be printed.**

Regarding claim 17, Manico et al discloses :

- in column 10, lines 38-44 that “[t]here are a variety of image products that may be ordered...[such as] hardcopy prints on photographic paper or other media...”  
Although Manico does not disclose a selection field to select the different types of prints, it would have been clear that a field for print format was needed in order to tell the machine which format the images were supposed to be printed in.

**15. Claim 18.**



- **one type of said selection fields designates, when marked, the number of prints of photographs corresponding to a particular thumbnail representation to be printed.**

Regarding claim 18, Manico et al discloses :

- in column 10, lines 29-31 that “[t]he system allows the user to take the images home and decide on the order as to whether or not additional copies or modifications are to be made.” Again, although Manico does not disclose a selection field to select the number of copies , it would have been clear that there had to have been a selection for the number of copies in order to tell the machine how many images to print.

**16. Claim 19.**

- **one type of said selection fields, when marked, designates that the photograph corresponding to the thumbnail representation is to be deleted from the digital film media.**

Regarding claim 5, the deletion of images from memory is a well-known process for saving storage in various storage mediums (such as RAMs, hard disks, removable storage, etc.) Although the Manico et al reference does not disclose any fields for the deletion of images, it would be a clear advantage to having such a field in order for the customer to easily delete unwanted images from the image storage medium.

**17. Claim 20.**

- **said processor is further arranged to read a unique identifier from the digital film medium via the first interface and to create and print out, using the print head, a unique sheet identifier on said selection sheet.**

Regarding claim 20, Manico et al discloses :

- in column 4, lines 30-36, that “[a] sensor 19 is provided for reading the film DX code on cartridge 18. The DX code contained information that can be used by apparatus 10 for determining if the film 13 contained therein is suitable for processing by apparatus 10...”
- as mentioned before in the rejection to claim 13, the computer controls all of the various components in the apparatus 10. The printer 80 would inherently have a print head used to print selection sheet. Since the computer controls all the components in the Manico et al reference, the computer must control the printer, and, in turn, the print head.
- In Fig. 12 and column 10 lines 2-3, that “[t]he order number 108 and image ID may be provided in any desired format, preferably a machine readable one.”

Although, Manico et al does not explicitly state these IDs are unique, it would only make sense to have these IDs be unique in order to avoid different orders having duplicate IDs.

**18. Claim 22.**

- **said unique sheet identifier comprises a bar code.**

Regarding claim 22, Manico et al discloses :

- in Fig. 12, and column 9, line 67 and column 10 line 1-2, that "...the image ID 109 is a bar code..." Although Manico et al does not explicitly state that the order number 108 is a bar code one can see from Fig.12 that it appears to look like a barcode (such as item 109).

III. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al (U.S. Patent No. 6,322,260) in view of Lee et al (U.S. Patent No. 6,264,384).

The Lee et al reference discloses a multi-function apparatus with a printhead and scanner module.

**19. Claim 14.**

- **said detector comprises a scanning mechanism associated with the print head of the printing means.**

The Manico et al reference disclosed a scanner that was associated with a film processing path, but does not explicitly mention any forms of detectors associated with the print head in the printer. The Lee et al reference discloses:

- in Fig. 2, and column 3, lines 22-25, that “[t]he scanning module 3 is mounted together with the inkjet printhead 6 on the carriage 20...”

Since the Manico et al reference disclosed a slot 110 for inserting order selection sheets, there should be some mechanism to read the order sheet. Furthermore, the order needs to be printed using the printer. An obvious choice would be to have a scanner along with a printhead as disclosed by the Lee et al reference to perform these tasks. The motivation would be to save space by combining a scanner and a printhead and to be able to improve Manico et al's invention by allowing it to effectively read order sheets and to print selected pictures.

**20. Claim 15.**

- **said scanning mechanism is attached to the print head and movable transversely across the feed path in response to signals from the processor.**

The Manico reference disclosed a printhead, but did not disclose any scanning module associated with it, nor did it disclose any movement of the two in combination.

However, the secondary reference, Lee et al discloses:

Art Unit: 2622

- in Fig. 2, and column 3, lines 22-25, that “[t]he scanning module 3 is mounted together with the inkjet printhead 6 on the carriage 20...”
- in column 3, lines 38-42, that “...the driving force generated by the CR motor 10 is transferred to the timing belt 15 to drive the carriage 20 connected to the timing belt 15. Thus, the scanning module 3 and the inkjet printhead 6 on the carriage 20 are moved along the guide shaft.” From Fig. 2, one can see that the movement the carriage is in a transverse direction in relation to the document.

IV. Claims 11,21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al (U.S. Patent No. 6,322,260), in view of Lesnick et al (U. S. Patent No. 4,760,606)

The Lesnick reference discloses an image file processing system that is capable of identifying highlighted areas in a document.

21. Claim 11.

- **in said step (iii) only those parts of the selection sheet corresponding to selection fields are inspected and the information gleaned from the inspection is processed to determine whether said selection fields are marked or unmarked.**

Art Unit: 2622

The Manico et al reference disclosed all of the limitation in claim 1, and disclosed that the order form 106 can be fed back into a slot 110 for further processing. However, it does not go into detail about what kind of inspection occurs. However, the tertiary reference, Lesnick et al discloses :

- in column 1, lines 62-65, that a "...smart scanner identifies highlighted data from the inputs documents and attaches special significance to highlight marks of predetermined shapes."

Since some sort of mechanism would be needed in order to inspect the order form, an obvious choice would be to use some sort of scanner. Since, the scanner as disclosed by Lesnick can identify highlighted marks, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a scanner as disclosed by Lesnick et al in Manico et al's invention. The motivation would be to allow automated reading of marked fields for more efficient processing of orders.

**22. Claim 21.**

- **said detector is further arranged for reading the unique sheet identifier and, the processor is arranged so that if the unique sheet identifier does not correspond to the unique identifier of the digital film media, then the performance of said one or more actions is inhibited.**

Art Unit: 2622

Regarding claim 21, the Manico et al reference only disclosed that some action is performed after reading in the order selection sheet, as explained in the claim 1 rejection above. However, it does not disclose what happens when there is not a match between the read identifier and a known identifier. The secondary reference, Lesnick et al, discloses :

- in column 10, lines 62-67 and column 11, lines 1-5, that “[t]he document processor server 404 seeks verification of the user identification number 616...and if verification is not received, the documents are rejected by the document processor 402...” Although the Lesnick et al reference uses the user ID number as an identifier instead of the barcode (item 602 of Fig. 6), it is well known that barcodes can be used for identification. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to have a process where identification numbers are compared and a decision is made, with this decision being the inhibition of some action if there is not a match between the identification numbers. This would be an advantageous addition to the invention as disclosed by Manico et al because it would prevent the further processing of the wrong documents or images if the identification numbers do not match.

**23. Claim 23.**

**A method for selecting prints of photographs from a digital film medium, the method being implemented by means of a printer having a scanning mechanism in the feed path, the method comprising:**

- **printing a selection sheet of thumbnail representations of photographs available on the digital film medium the selection sheet further comprising a plurality of selection fields**
- **each thumbnail representation being associated with at least one selection field;**
- **marking one or more of said selection fields according to a user choice of photographs to be printed;**
- **feeding the marked selection sheet into the printer feed path for scanning by the scanning mechanism to detect which of the selection fields has been marked;**
- **and printing photographs stored in the digital film medium in accordance with the marked selection fields.**

Regarding claim 23, the first three limitations of the claim have been addressed in the claim 1 rejection. Regarding last two limitations, the Manico et al reference disclosed that the order for 106 is fed into a reception slot 110 for further processing (see claim 1 rejection above). Although Manico et al does not go into further detail, it would make sense to feed the order sheet to the printer since one would want to print the selected images. The secondary reference, Lesnick et al discloses :



- in column 1, lines 62-65, that a "...smart scanner identifies highlighted data from the inputs documents and attaches special significance to highlight marks of predetermined shapes." The motivation for combining the two references is discussed in the claim 11 rejection above.

Regarding the printing of photographs, Manico et al does not explicitly state the printing of the images from the order sheet in this particular embodiment (apparatus 10)

However, Manico et al discloses :

- in column 10, lines 55-60, "...a first printer section for printing images..."

Although this is a different embodiment than Manico et al's embodiment with the order sheet 106 as discussed throughout this office action, Manico et al does disclose in column 10, lines 54-55, that "[this embodiment] is similar to the apparatus 10 [as discussed], with like numbers indicating like parts and operation." Thus, it would be clear that the printer 80 in Manico et al's first embodiment would be used for performing the same function.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is 703-306-4142. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

JOSEPH MANCUS  
PRIMARY EXAMINER